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No. 20,599
United States Court of Appeals
For the Ninth Circuit

HENSLEY EQUIPMENT COMPANY, INC.,	}	<i>Appellant,</i>
vs.		
ESCO CORPORATION,		

APPELLANT'S BRIEF

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<i>Appellee.</i>	

APPELLANT'S BRIEF

Appellant, Hensley Equipment Company, Inc., files this brief in support of its appeal from a judgment of the United States District Court for the Northern District of California, Southern Division. The district court found that appellant infringes United States Letters Patent No. 2,483,032, issued to Josef Baer, on September 27, 1949 for an Excavating Tooth. As a matter of convenience, appellant, Hensley Equipment Company, Inc., is referred to in this brief as "Hensley"; and appellee, Esco Corporation, is referred to as "Esco". The record on this appeal has been prepared under amended Rule 10 of this Court. References to the record will be indicated herein by the designation (Clk. Tr.....) in reference to the clerk's transcript and (Rep. Tr.) in reference to the reporter's transcript of the trial.

JURISDICTIONAL STATEMENT

Jurisdiction of the district court was based upon 35 U.S.C. §281 (1952) and 28 U.S.C. §1338 (1948).

The Complaint and Amended Complaint seek relief under the patent laws of the United States (Clk. Tr. 1, 2, 15, 16).

Jurisdiction of this court over the appeal from the judgment is based upon 28 U.S.C. §1292(a) (1) and (4) (1948). The judgment of the district court grants an injunction and is final except for accounting (Clk. Tr. 520A-520C).

This appeal is timely prosecuted under 28 U.S.C. §2107 (1948). The judgment appealed from was entered on September 27, 1965 (Clk. Tr. 520A-520C) and the Notice of Appeal was filed on October 25, 1965 (Clk. Tr. 520).

STATEMENT OF THE CASE

A. The Parties.

Esco is an Oregon corporation, located in Portland, Oregon, whose business includes the manufacture and sale of expendable products for construction equipment, such products including excavating teeth (Rep. Tr. 44, 44A).

Hensley, at the time of the proceedings in the district court, was a California corporation, located in San Leandro, California. Since that time, Hensley has moved from California and is now located in Dallas, Texas. Hensley's business also includes the manufacture and sale of expendable parts for construction equipment, including

excavating teeth and replacement wear-points for those teeth (Rep. Tr. 308, 309).

B. Subject Matter of the Suit.

The subject matter of the Baer patent No. 2,483,032, in suit (Pl. Ex. 2—hereinafter referred to simply as the Baer patent) is excavating teeth. Excavating teeth are devices which fit upon the front or cutting edges of dip-pers, shovel buckets and the like, and serve to break up the earth or rock in which the equipment is working (Rep. Tr. 47).

The particular excavating teeth of concern in this suit have two parts—an adaptor and a wear-point. The adaptor is shown in the Baer patent at Figure 7 and is also designated by the reference numeral 20 in Figures 1 and 2. This adaptor fits upon the lip of a dipper bucket, or the like. The wear-point is shown in the Baer patent at Figure 6 and is also designated by the reference numeral 42 in Figures 1 and 2. The wear-point fits upon the adaptor and provides the actual cutting edge of the overall tooth. The overall tooth, including the wear-point and the adaptor, is shown in Figures 1 and 2 of the Baer patent. During the trial, Esco offered a small plastic model (Pl. Ex. 1) and Hensley offered a lightweight wooden model (Def. Ex. FF) for the purpose of illustrating the actual tooth. These models will be beneficial here for the same purpose.

C. The Prior Art.

For consistency in discussing the prior art, the above and related terms will be used in a consistent manner

despite a wide discrepancy in the terminology in the prior art patents themselves and in the industry in general.

1. The Thomas Patent—No. 915,809.

On October 30, 1908, Valentine C. Thomas filed an application for United States patent on a Dipper Tooth. Thomas's tooth was of the two part variety including an adaptor, designated by the reference numeral 10 in his patent (Def. Ex. N, Fig. 2) together with a wear-point as shown in Figures 2, 3, 4 and 5 (Rep. Tr. 413).

In the Thomas patent the adaptor 10 included a nose portion which, as can be seen in Figures 1 and 3, is generally wedge shaped. The wear-point itself of the Thomas patent includes a socket shaped to conform with and fit upon the nose 15 of the adaptor (Rep. Tr. 413).

Thomas's application issued into patent No. 915,809 on March 23, 1909.

2. The McKee Patent—No. 1,780,397.

On August 29, 1928, Walter S. McKee and Eugene C. Bauer filed an application for patent on a Dipper Tooth. McKee's dipper tooth was also of the two part variety including an adaptor and a wear-point. The adaptor is designated by the reference numeral 4 in Figures 1 through 4 of his patent (Def. Ex. AA) and also as shown separately in Figure 6. The wear-point is designated by the reference numeral 5 in the various figures and is shown separately in Figure 7. In McKee, the wear-point includes a socket 21 formed by the jaws 17 shown in Figures 7 and 8. The jaws 17 "fit against the diverging sides of the nose 7" of the adaptor (Def. Ex. AA, p. 2,

ll. 7, 8) as seen particularly in Figures 3 and 8. The rearward portion of the wear-point, at the back of the jaws 17, is spaced from the forward portion of the adaptor adjacent the jaws 17 (Rep. Tr. 502).

The McKee patent issued on November 4, 1930.

3. The Mekeel Patents.

a. The First Mekeel Patent—No. 1,845,677.

On March 9, 1929, Van Cortright Mekeel filed an application for patent for a Digging Tooth. In this particular patent (Def. Ex. BB) two embodiments of a tooth are shown, both of which are of the two part variety. In the first embodiment, shown in Figures 1 to 6, the two part tooth includes an adaptor 12 formed with a socket 15, together with a wear-point 13, formed with a shank 14 to fit into the socket of the adaptor.

In the second embodiment, shown in Figures 7 through 10, the two part tooth includes an adaptor designated by reference numeral 12a including a forwardly extending nose portion designated by the reference numeral 14a. The adaptor is shown separately in Figure 9 and the wear-point in Figure 8. The wear-point is shown mounted on the adaptor in Figures 7 and 10 (Rep. Tr. 471).

In this second embodiment of the Mekeel patent (Def. Ex. BB), the upper and lower faces of the nose 14a converge to form a truncated wedge and, as apparent from Figure 8, the socket of the point is also wedge shaped. At the joint between the rear of the wear-point and the forward shoulder of the adaptor, there is a tongue and recess configuration shown principally in Figure 7. As shown, the wear-point has recesses 24 while the adaptor

includes tongues 23. As can be seen from the drawings (particularly Figures 7 and 9) upper and lower edges of the tongue and recess are parallel not only to each other but also to the upper wedge face of the adaptor nose (Rep. Tr. 472, 473, 475). As can be seen in Figure 10, there is a space between the adaptor and the wear-point at the vertex of the socket (Rep. Tr. 474).

Mekeel patent No. 1,845,677 (Def. Ex. BB) issued on February 16, 1932, and for convenience, will be referred to herein simply as the Mekeel '677 patent. During the trial, Hensley offered a lightweight wooden model (Def. Ex. KK) of the structure shown in Mekeel '677 patent for purposes of illustration. The model will be beneficial here for the same purpose.

b. The Second Mekeel Patent—No. 1,951,988.

On December 30, 1931, prior to the issuance of his '677 patent (Def. Ex. BB), Mr. Mekeel filed another patent application for a Digger Tooth. This second patent (Def. Ex. QQ) is directed to a tooth, as stated by Mekeel:

“of the kind described in my pending application Serial Number 345,719 filed March 9th, 1929 now Patent No. 1,845,677 [Def. Ex. BB];—that is to say, it is a digging tooth including a part having a socket and a part having a slotted tenon engaged in said socket with means for expanding the tenon in the socket to lock the two parts together.” (Def. Ex. QQ, p. 1, ll. 7-14)

In his second patent, Mekeel stressed the spacing between the wear-point and the adaptor (Rep. Tr. 495), stating that the reason for the spacing is so that:

“any wear on the contacting parts will be taken up and compensated for by further driving the [point] . . . towards the [adapter] . . . with no possibility of the shoulders 20 or the ends of the projections 18 engaging and thereby limiting that movement.”

(Def. Ex. QQ, p. 1, ll. 93-98)

This second Mekeel patent, No. 1,951,988 (Def. Ex. QQ) was issued March 20, 1934, and for convenience is referred to herein simply as the Mekeel '988 patent.

4. The Seal Patent—No. 2,134,344.

On May 21, 1937, Stanley Seal filed a patent application for a Dipper Shovel Tooth. This patent (Def. Ex. R) also relates to a two part tooth including an adaptor lettered B and a wear-point numbered 23 (Rep. Tr. 414). As can be seen in Figures 1 and 2 of the Seal patent, the wear-point has a wedge shaped socket 25 adapted to engage the wedge shaped nose 27 of the adaptor. In this instance, the wear-point includes rearwardly projecting wedge shaped tongues 24 which fit into and “interlock with recesses 28 in opposite sides of the [adaptor]. . . .” (Def. Ex. R, p. 1, col. 2, ll. 48, 49) (Rep. Tr. 414, 415).

The Seal patent issued October 25, 1938.

5. The Hosmer Patent—No. 2,251,487.

On April 17, 1939, Chester C. Hosmer and Ernie L. Launder filed an application for patent on a Tooth Point. Here again the patent (Def. Ex. S) is for a point of the two part variety including an adaptor numbered 10 in the drawings and a wear-point. Here again the wear-point includes a generally wedge shaped socket to cooperate with a wedge shaped nose 13 on the adaptor. In this patent, as

is apparent from Figures 2 and 3, the upper wall or spike 22 of the wear-point is considerably heavier than the side and bottom portions 28 and 29 (Rep. Tr. 506).

The Hosmer patent issued August 5, 1941.

6. The Crawford Patent—No. 2,312,802.

After filing applications for two earlier patents (Def. Exs. T and U) Arthur N. Crawford filed, on January 31, 1942, an additional patent application for a Locking Device for Bucket Teeth. This later patent (Def. Ex. V) shows another tooth of the two-part variety including an adaptor and wear-point. Here again the wear-point includes a wedge shaped socket adapted to engage the wedge shaped nose of the adaptor. The wear-point includes a "heavy, plate-like blade" (Def. Ex. V, p. 1, col. 2, ll. 25, 26).

As can be seen in Figure 3 of the Crawford patent (Def. Ex. V) there is a space between the rearward edge of the wear-point and the forward edge of the adaptor, adjacent to shoulder 3. Also, there is a space between the adaptor and the wear-point at the vertex of the nose 2 and socket (Def. Ex. V, Fig. 3). A pin 17 is used to join the wear-point to the adaptor and the pin is held in place by means of a resilient member or spring 15.

In the Crawford patent, the spring 15 and the spacing between adaptor and wear-point cooperate to allow for wear between the parts. As stated by Crawford:

"[i]f, during subsequent digging operations, the [wear-point] . . . should become loose on [the adaptor] . . . the strong spring being already compressed will exert sufficient force to advance the pawl

[numbered 13 in Figure 1] against tongue 12 so as to take up all lost motion”.

(Def. Ex. V, p. 2, col. 1, ll. 41-46)

The Crawford patent issued March 2, 1943.

7. The British Patent—No. 565,417.

On June 5, 1942, Aktiebolaget Bofors filed a patent application in Sweden and on May 6, 1943, a corresponding application was filed in the United Kingdom. This latter application issued as British Patent No. 565,417 (Def. Ex. DD), on November 9, 1944.

This British patent is for an excavating tooth including a wear-point numbered 4, which fits on the wedge shaped nose 2 of the adaptor. The wear-point and adaptor are spaced from each other at the rearward portion of the wear-point (Rep. Tr. 504), as well as at the vertex of the nose 2 and socket 3 (Def. Ex. DD, Figs. 1 and 2). The wear-point is secured to the nose of the adaptor by means of a resilient spring numbered 8, in cooperation with a pin numbered 5. The spacing and the spring cooperate to allow for wear. In the language of the British patent, “In this way the [wear-point] . . . is firmly secured to the [nose of the adapter]. . . .” (Def. Ex. DD, p. 1, ll. 60-62).

8. The White Patent—No. 2,325,991.

On April 7, 1943, Marshall J. White, filed an application for patent for a Bucket Tooth Unit. The tooth shown in this patent (Def. Ex. W) is also of the two part type including an adaptor numbered 1 and a wear-point 6. Here again the wear-point includes a wedge shaped socket for cooperation with the wedge shaped nose of the adaptor.

As can be seen particularly in Figure 3, the upper portion of the wear-point is of considerably greater thickness than the lower portion (Rep. Tr. 507).

The White patent issued August 3, 1943.

D. The Baer Patent in Suit.

The application for the Baer patent in suit was filed June 6, 1945, more than one year subsequent to the issue dates of each of the prior art United States patents described above. During the course of prosecution before the Patent Office, the Examiner cited a number of prior art patents including some of those described above but not including the McKee patent (Def. Ex. AA), the British patent (Def. Ex. DD), nor either of the Mekeel patents (Def. Exs. BB and QQ).

1. The Structure Defined in the Baer Patent.

The Baer patent relates to an excavating tooth of the two part type including an adaptor numbered 20 and shown separately in Figure 7, and a wear-point numbered 42 and shown separately in Figure 6. The wear-point includes a wedge shaped socket 45 adapted to engage the wedge shaped nose 26 of the adaptor.

The upper wall or spike 43 of the wear-point, as shown in Figures 3 and 5 of the drawings, is of thicker or heavier section than either the side or bottom walls. In the descriptive portion of the patent, this spike is mentioned no less than nine times (Pl. Ex. 2, col. 2, l. 47; col. 3, ll. 22, 24, 29, 30, 35, 37 and 47 and col. 4, l. 27) but nowhere is found any reason for its being heavier than the other walls or even heavy at all.

In the descriptive portion of the patent there is not even a mention of the spike's "relative" heaviness and, in fact, no comment whatsoever is made on the thickness, weight or heaviness of the spike.

As can be seen particularly in Figure 2 of the Baer patent, the joint between the rear of the wear-point and the forward shoulder of the adaptor includes a tongue and recess configuration. In this instance rearwardly extending tongues are on the wear-point and cooperating recesses are on the adaptor. The upper and lower surfaces of both the tongues and the recesses are substantially parallel, not only to each other, but also to the upper wedge face of the nose (Pl. Ex. 2, col. 2, ll. 35-41). The manner of cooperation and the purpose of the tongues is set forth in the patent as follows:

"Since the tongues 48 are provided on the tooth point 42 to improve the lateral stability of the tooth point with respect to the adapter as well as to prevent relative movement or creeping between the tooth point and the adapter, the tongues desirably fit snugly between the substantially parallel upper and lower surfaces 38 and 39 of the recesses 37". (Pl. Ex. 2, col. 3, ll. 4-11)

As can be seen particularly in Figure 3 of the Baer patent, there is space between the wear-point and adaptor at the rear of the tongues 48; at the shoulders 32 and 36; and also at the vertex of the socket and nose 26. As can be seen in Figure 3, the wear-point is held onto the adaptor by means of a pin 65, which is retained by a resilient member 50. The pin extends through an opening 63 in the spike 43 and part way through an opening 58 in the

adaptor nose. The pin seats against the back wall of both openings 63 and 58.

The purpose of these various spaces is set forth in the descriptive portion of the patent as follows:

“The length of the tongues is preferably less than the longitudinal depth of the recesses 37 to provide a clearance, as indicated at 49 in Figure 2, between the end surfaces of the tongues and recesses so that the seating of the tongues may not interfere with the firm seating of the tooth point upon the nose of the adapter”. (Pl. Ex. 2, col. 3, ll. 11-18)

. . .

“To allow for wear and the effects of impact against the tooth point in use, the dimensions of the nose relative to those of the socket are such as to provide end clearances, as shown in Figures 2 and 3 between the inner end of the socket and the rounded end 30 of the nose as well as between the surfaces of the tooth point adjacent the open end of the socket and the shoulders at the forward end of the shank portion 22 of the adapter.” (Pl. Ex. 2, col. 3, ll. 60-68)

The general features of the Baer patent are summarized by Baer as follows:

“... the disclosed construction provides coacting tooth point and adapter parts which effect and maintain firm seating engagement of the tooth point upon the adapter and prevent relative lateral or longitudinal movement between the adapter and tooth point. In addition, the tooth point is removably held in position by a readily accessible and easily removed key.”

(Pl. Ex. 2, col. 4, ll. 64-72)

2. The Claims of the Baer Patent In Suit.

The Baer patent includes nine claims. Claims 1 through 7 specifically relate to the adaptor portion of the tooth either alone or in combination with the wear-point. Claim 5, directed to the combination of the adaptor and the wear-point, was charged at the trial to be infringed by way of inducement. No inducement was found by the district court and consequently, Claim 5 was found not infringed and is not in contest here. Claims 8 and 9 of the Baer patent, directed to the wear-point itself, were charged and found by the district court to be infringed.

a. Claim 8.

Claim 8 of the Baer patent (Pl. Ex. 2, col. 7, l. 66) begins by defining the *adaptor* which the wear-point is "adapted to receive". The adaptor is recited as having a wedge shaped nose with a rounded front end and parallel side faces together with an enlarged rear shank portion including recesses. The recesses are recited as having edges which are parallel not only to each other but also to one of the wedge faces of the nose. The claim continues and defines the wear-point itself as including:

1. "a spike portion of relatively heavy section,"
2. "a housing portion having side walls"
3. "and an integral web"
4. "forming with the spike portion, a wedge-shaped socket having an open end at one end of the spike portion,"
5. "said wedge-shaped socket being of a depth and shape normally and firmly to receive the wedge-shaped nose of the adapter with space between the nose [*sic*] and adapter at the vertex of the socket"

6. "and with the spike and housing portions substantially spaced from the shank portion of the adapter,"
7. "and said side walls of the housing portion having integral projecting tongues thereon adjacent the open end of the socket,"
8. "and said tongues having substantially parallel side edges adapted to fit into said recesses of the adapter shank portion when the nose is seated in the socket, thereby to support the tooth [*sic*] on the adapter in directions transverse to the wedge faces."

Here in Claim 8 and in one other claim, Claim 6 (not here in issue), are the only places in the entire patent in which the weight of the "spike portion" is mentioned. Here and in Claim 6, it is recited that the spike portion is "of relatively heavy section". But neither claim (nor any other portion of the patent) indicates why it is relatively heavy or with respect to what it is relatively heavy.

Claim 8 also particularly recites that the dimensions of the socket are such that when seated on the adaptor there is a space between the wear-point and the adaptor at the vertex of the wear-point socket. This refers to the space shown in Figure 3 of the patent, at reference numeral 30. The claim also recites that the spike and housing portions of the wear-point are substantially spaced from the shank of the adaptor. This refers to the space at the shoulders 32 and 36 of Figure 3.

Claim 8 also recites that the wear-point includes projecting tongues and further that the tongues have "substantially parallel side edges". These so-called "side

edges'' refer to the upper and lower edges as shown at 38 and 39 in Figure 2 of the patent (Rep. Tr. 422).

Claim 8 goes on to recite that these tongues with their substantially parallel upper and lower edges are "adapted to *fit* into said recesses of the adapter shank portion" (emphasis supplied) when the nose is seated in the socket. Referring to Figure 3 of the Baer patent this language defines the interfitting relationship of the tongues and the recesses at a time when the wedge faces of the wear-point socket are pushed all the way back on the nose of the adaptor (Rep. Tr. 263).

b. Claim 9.

Claim 9 of the patent, like Claim 8, begins by describing the adaptor upon which the wear-point is seated. The adaptor is described as having a wedge shaped nose with an enlarged shank portion and recesses in the shank portion having edges which are parallel to each other and to one of the wedge faces. The claim then goes on to describe the point to which it is directed as including:

1. "integral spike and housing portions"
2. "together forming a wedge-shaped socket"
3. "having wedge faces of an angularity substantially equal to that of the diverging adapter wedge faces"
4. "and lengths such that the adapter nose is normally spaced from the socket vertex,"
5. "said housing portion having opposed and integral side tongues thereon displaced laterally of socket wedge faces and projecting rearwardly from the housing portion,"
6. "said tongues having substantial parallel edges and parallel relationship to one of the socket wedge faces

and adapted to fit between parallel edges of said recesses to provide support for the tooth point in addition to the wedge faces,”

7. “and said tongues being normally too short to reach the ends of said recesses so as to present the interference with the seating of the wedge faces.”

Claim 9 is very similar to Claim 8 but with certain differences. In Claim 9 there is no statement that the spike portion is relatively heavy. In Claim 9, like in Claim 8, there is a spacing recited at the vertex of the socket but there is no general space recited between the adaptor and the wear-point. Claim 9 does, however, recite a space between the rearward portions of the tongues and recesses in the adaptor. This is the space shown at 49 in Figure 2 of the Baer patent.

With respect to the parallel relationship of the tongue surfaces, Claim 9 differs from Claim 8, in that Claim 8 recites the relationship between the upper and lower edges of the tongue and recess as being *substantially* parallel with one of the wedge faces. Claim 9 recites that the edges of the tongues are substantially parallel with each other but that they are “in parallel relationship to one of the socket wedge faces”.

c. Claim 5.

While Claim 5 is not here in contest its recitations are important in that Claim 5 does not include any recitation of tongues or recesses on either the point or the adaptor. Rather, Claim 5 recites among its several elements, “additional means stabilizing the tooth point relative to the adapter in a direction laterally of the nose,”. The addi-

tional means are means in addition to the wedge faces themselves which, according to Baer, “provide effective and durable gripping surfaces on the projecting nose 26 and within the coacting socket 45, it is preferred that the surfaces which seat together shall be the wedge surfaces of the parts” (Pl. Ex. 2, col. 3, ll. 50-54). In the Baer patent the only *additional* means are the parallel edged coacting tongues and recesses (Rep. Tr. 241, 242).

3. The Baer File Wrapper—Defendant’s Exhibit M.

The claims here under consideration, Baer Claims 8 and 9, were known as Claims 17 and 18 during the prosecution of the Baer patent application. These claims were first added by an amendment to the application received in the Patent Office September 18, 1947. In the paper in which these claims were added, Baer’s attorney made certain remarks concerning them and these remarks appear in the file wrapper (Def. Ex. M), at pages 35 to 37.

At page 35 of the file wrapper Baer’s attorney emphasized the need for spacing between the point and the adaptor so as to allow for wear.

At page 36 of the file wrapper, Baer’s attorney stated the reasons for the parallel edges on the rearwardly extending tongues. Here the attorney stated:

“Additionally, the bracing action of the tongues is effected through *parallel side edges* thereof which are parallel to one of the wedge surfaces, so that those tongues do not interfere with the continued seating engagement of the tooth point on the adapter nose. . . . Thus, while the tooth point may move longitudinally of the adapter nose to maintain seating engagement of the wedge surfaces, the *parallel edges of the*

tongues remain in engagement with the edges of the recess without interfering with the longitudinal seating of the tooth point on the adapter nose'' (emphasis supplied)

On that same page 36 of the file wrapper, Baer's attorney emphasized that Claims 17 and 18 were devoted to a point "having specific structural details for effecting the maintenance of the seating engagement between the co-acting wedge and tongue surfaces of an adapter".

On page 37 of the file wrapper Baer's attorney characterized the Seal patent (Def. Ex. R) described above as follows:

"The Examiner has apparently relied upon the disclosure of the Seal patent to indicate the use of tongues on the side of a tooth point. It is to be observed that *the side tongues of Seal would be useless in the applicant's disclosed structure, because they are wedge-shaped* and, consequently, could not be made to maintain engagement for reinforcing purposes during any longitudinal movement of the tooth point relative to the adapter." (emphasis supplied)

E. The Esco Commercial Structures.

The Esco commercial structures can be classified into three groups. The first group includes the Esco Models R-4, R-5, R-6 and R-7, of which the R-6 is representative and is as shown in the drawing (Pl. Ex. 25).

The second group of the Esco commercial points includes the Esco Model R-3 (Def. Ex. A) and one manufactured by Esco for Caterpillar Tractor Co., Model 2K4678 (Def. Ex. D). The third type of Esco commercial point is Esco's Model R-34S (Def. Ex. B).

Each of the above mentioned points manufactured commercially by Esco is marked with the number of the Baer patent in suit—No. 2,483,032.

1. The Esco R-4, R-5, R-6 and R-7 Wear-Points.

As shown in Plaintiff's Exhibit 25 the Esco R-6 wear-point includes rearwardly extending tongues having non-parallel upper and lower edges. Moreover, as can be seen from the same exhibit the lower edge of the Esco tongues does not contact the lower edge of the recess in the adaptor.

In this group of commercial points, the wear-point is retained on the adaptor by a pin extending through the top of the point and partially through an opening in the nose of the adaptor (Rep. Tr. 109) but the pin does not contact the rear wall of the opening in the adaptor (Rep. Tr. 111, 112).

2. The Esco R-3 and the Caterpillar 2K4678.

In this classification of point there is no rearwardly extending tongue at all but rather a slight depression or recess at the rear edge of the wear-point. In the case of these two commercial teeth the pin extends through both the upper and lower walls of the wear-point (Rep. Tr. 229, 230).

3. The Esco R-34S Point.

In this instance, the Esco commercial wear-point does not include rearwardly extending tongues but rather includes forwardly extending recesses. As stated by Esco's own witness (Rep. Tr. 249, 592) these forwardly extend-

ing recesses are additional stabilizing means when cooperating with forwardly extending tongues on the mating adaptor (Def. Ex. C).

F. The Accused Hensley Points.

A number of different Hensley points have been accused of infringement. These include early models which were manufactured prior to 1961 and exemplified broadly by Plaintiff's Exhibit 4 (Rep. Tr. 116). As to the small number of points involved in this early activity, infringement has been admitted if the patent is valid (Clk. Tr. 216, 217). In 1961, following a charge of infringement by one of Esco's representatives, Hensley changed the configuration of its wear-points (Rep. Tr. 319, 320) to that exemplified broadly by Plaintiff's Exhibit 5. The accused points in the changed configuration include four different sizes—4 inch (Pl. Ex. 5), 5 inch (Def. Ex. J), 6 inch (Pl. Ex. 10) and 7 inch (Pl. Ex. 32) having the respective Hensley model Nos. R-4HX, R-5HX, R-6HX and R-7HX.

While the Hensley points differ from the Esco points of similar model designation, the Hensley wear-points were manufactured to be used with the various sized Esco adaptors (Rep. Tr. 183). The Hensley points are *replacement* points and are, therefore, dimensionally similar to those originally supplied by Esco (Rep. Tr. 171, 316, 317) but there are certain differences over the Esco models. A specific difference resides in the shape of the rearwardly extending tongues (Rep. Tr. 173, 174, 320).

Each of the Hensley points includes rearwardly extending tongues but in the case of each different size of Hensley point, the shape of the tongues is different. In

the Hensley R-4HX wear-point (Pl. Ex. 5) the angle between the upper and lower surfaces of the rearwardly extending tongues is about 60° (Rep. Tr. 352, 353). The Hensley model R-6HX (Pl. Ex. 10) has tongues with upper and lower faces at an angle of about 35° (Rep. Tr. 353, 354) (Def. Ex. TT). With respect to the Hensley R-7HX (Pl. Ex. 32) the rearwardly extending tongues have upper and lower edges at an angle of between 5° and 15° (Rep. Tr. 665-667). As is apparent from Defendant's Exhibit J, the Hensley R-5HX point has rearwardly extending tongues with an angle somewhat between that of the R-4HX and the R-6HX; that is between 35° and 60° .

G. Esco's and Hensley's Tests for Infringement.

In order to show that the accused Hensley points provide the stabilization set forth in the Baer patent, Esco tested two of Hensley's points (Pl. Exs. 9 and 10), both points being of the six inch size. The test was made by attaching the Hensley point on an Esco adaptor specially ground for the purposes of the test (Rep. Tr. 105) and rigidly clamping the adaptor (Rep. Tr. 71). A heavy weight was then dropped like a guillotine, onto the tip of the wear-point to see if the force of the dropped weight could urge the rearwardly extending tongues of the Hensley wear-point into contact with the specially ground recesses of the test adaptor (Rep. Tr. 202).

Esco's previous experience with this guillotine test showed that the normal test impact was 6,000 foot-pounds (Rep. Tr. 63). One of the Hensley points (Pl. Ex. 9) was tested at 16,000 foot-pounds at which point it fractured (Rep. Tr. 65). The other Hensley point (Pl. Ex. 10) was

tested at 18,000 foot-pounds (Rep. Tr. 67). No determination was made on either of the Hensley points as to whether or not the tongues contacted the recesses at the normal test impact of 6,000 foot-pounds (Rep. Tr. 76, 77).

Hensley also tested for infringement but instead of using an impact, Hensley applied steadily increasing pressure until the tooth—either the wear-point or the adaptor—broke. Hensley tested his own 4, 5, and 6 inch points (Rep. Tr. 324) and recorded these tests on a motion picture film (Def. Ex. H). With this test no support was found between the Hensley tongues and recesses until the tooth was actually destroyed (Rep. Tr. 325, 326). Esco's witness, Dr. Graf admitted that the Hensley test, at least in so far as the 4 inch point was concerned, was a fair test (Rep. Tr. 574).

H. The Trial and Decision.

The trial of this cause was held from October 6, 1964 (Rep. Tr. 2) through October 9, 1964 (Rep. Tr. 477). The trial court did not issue its Memorandum Opinion and Order until September 8, 1965—eleven months after trial (Clk. Tr. 474). The Finding of Fact, Conclusion of Law and Judgment were filed promptly thereafter on September 27, 1965 (Clk. Tr. 517, 518, 520A).

QUESTIONS INVOLVED ON APPEAL

This appeal involves directly two main questions and indirectly a number of subordinate issues as set forth in the Specification Of Errors Relied Upon. The two main questions are:

1. Does The Baer Patent Disclose Patentable Novelty Over The Prior Art?

This question arises on the face of the Baer patent itself, on the prior art patents in general and specifically on the prior art Mekeel '677 patent (Def. Ex. BB). The district court considered the Mekeel '677 patent at length and found "It would appear that teeth based on the Mekeel patent, the defendant's most pertinent over all reference against the Baer patent, were never actually constructed and thus never put to any commercial use or test" (Clk. Tr. 489) and that "the Mekeel patent was never utilized, and no known manufacture resulted from which its effectiveness could be evaluated." (Clk. Tr. 494). The district court also found that the tongues on the Baer point were not true equivalents to the tongues on the Mekeel adaptor (Clk. Tr. 493); that "Mekeel does not rely on tongues for additional stabilization, since a rigid lock is brought about by the expanded tenon which provides the connection between the point and the adaptor" (Clk. Tr. 495) and that Mekeel does not have a "heavy upper spike portion" on the point (Clk. Tr. 494). The district court also found "that the combination of the elements found in each of Claims 8 and 9 result [in] something new, a new co-action between elements, which would not have been obvious to one skilled in the particular art at the time invention was made".

2. If Claims 8 And 9 Of The Baer Patent Are Valid, Are They Infringed By The Hensley Points?

This question arises on the physical exhibits of the Hensley points presented at trial, the file wrapper of the Baer patent (Def. Ex. M) and on the face of the Baer patent itself. The district court, after noting the admitted infringement of the “first one hundred and nine points” (Clk. Tr. 482), found that “the defendant’s change in design and construction of its new points is insufficient to avoid its previously admitted infringement of these two claims” (Clk. Tr. 483). The district court reviewed evidence relating to tests for infringement and found “the Hensley tests, which were in the main made on smaller sized points (where the additional stabilization effect has lesser importance), were variable and impossible to evaluate . . . and no effort was made to test the larger seven inch point” (Clk. Tr. 485) and that “[t]he court is satisfied that the tongues on the Hensley-Esco type point serve the above indicated stabilization purpose and that this is the very reason they were retained” (Clk. Tr. 486). The district court also found that “[w]hile the sides of tongues on the smaller size Hensley-Esco type points may or may not be said to be substantially parallel, the sides of the tongues on the larger, seven inch, sized Hensley-Esco type points appeared to be as close to substantially parallel as measurement could provide” (Clk. Tr. 484). The district court also found “that the evidence does not sustain defendant’s defense of file wrapper estoppel” (Clk. Tr. 497).

SPECIFICATION OF ERRORS RELIED UPON

Hensley has condensed its specification of errors into two questions for this Court as set forth above.

To comply with Rule 18, Paragraph 2(d) of this Court, each error intended to be urged is set out separately and particularly as follows:

1. The Court erred in holding Claims 8 and 9 of United States Patent No. 2,483,032 to Baer, valid and infringed.

2. The Court erred in holding that "the defendant's change in design and construction of its new points is insufficient to avoid its previously admitted infringement of these two claims" and was "at most a colorable change."

3. The Court erred in holding Claims 8 and 9 of said Baer Patent No. 2,483,032 generally infringed by defendant's points without differentiation as to the various models of points.

4. The Court erred in construing Claims 8 and 9 of said Baer Patent No. 2,483,032 such as to find the basic features thereof in the defendant's points.

5. The Court erred in holding that the tongues on the defendant's points in general serve a stabilization purpose without differentiation as to various models of points.

6. The court erred in giving a broad interpretation to the term "substantially parallel", as such term is used in Claims 8 and 9 of said Baer Patent No. 2,483,032, in order to find infringement thereof.

7. The Court erred in failing to hold that Claims 8 and 9 of said Baer Patent No. 2,483,032 are limited by the

statements made in the file wrapper of that patent and, as so limited, are not infringed.

8. The Court erred in failing to hold Claims 8 and 9 invalid in view of United States Patent No. 1,845,677 to Mekeel.

9. The Court erred in construing said Mekeel Patent No. 1,845,677 and said Baer Patent No. 2,483,032 such as to find that the tongues on the adaptor of said Mekeel patent are not a true equivalent to the tongues on the point which fit into the recesses of the adaptor of said Baer patent.

10. The Court erred in construing said Mekeel Patent No. 1,845,677 to find that the point described therein is symmetrical.

11. The Court erred in construing said Mekeel Patent No. 1,845,677 so as to find that the point described therein does not provide a heavy upper spike portion.

12. The Court erred in holding that the features of said Baer Patent No. 2,483,032, as expressed in Claims 8 and 9 directed to a point only, include "spacing between the point and the adapter."

13. The Court erred in finding that the tooth of said Mekeel Patent No. 1,845,677 does not include spacing between the point and adaptor.

14. The Court erred in construing said Mekeel Patent No. 1,845,677 such as to find that it was never utilized and that no known manufacture resulted from which its effectiveness could be evaluated.

15. The Court erred in construing the prior art patents, including said Mekeel Patent No. 1,845,677, such

as to find that each has “less than the full combination of elements specified in either Claims 8 or 9.”

16. The Court erred in basing its holding of validity of Claims 8 and 9 of said Baer Patent No. 2,483,032 upon a comparison of the prior art with structures manufactured by the plaintiff rather than with the structure defined by said Claims 8 and 9.

17. The Court erred in basing its holding of validity of Claims 8 and 9 of said Baer Patent No. 2,483,032 upon a comparison of the entire tooth structure of said Mekeel Patent No. 1,845,677 rather than to the structure of the point alone to which Claims 8 and 9 are directed.

18. The Court erred in holding that the combination of elements found in each of Claims 8 and 9 of said Baer Patent No. 2,483,032 would not have been obvious to one skilled in the particular art at the time the alleged invention was made.

SUMMARY OF ARGUMENT

A. The Invalidity of the Baer Patent.

As tested under the patent laws, demanding both novelty and non-obviousness, the Baer patent must fall. It has been stripped of its initial, but rebuttable, statutory presumption of validity by the Patent Office's failure to consider the most pertinent prior art. Esco's attempts to bolster the initial presumption with a showing of commercial success is not even to be considered because of a complete absence of any showing that the success was due to the patented features. Even so, commercial success is at best a makeweight in cases of questionable patent validity.

Here the invalidity of the Baer patent is not questionable. The prior art Mekeel '677 patent teaches the same structure as set forth in the Baer patent claims in issue. The alleged differences between Mekeel and Baer are nonexistent. Mekeel teaches Baer's interacting tongues and recesses for Baer's same purpose of stabilization. But even if it did not, Esco has admitted the equivalency of the Mekeel and Baer structures in this respect. The spacing between the wear-point and adaptor is admitted by Esco to be inherent in the Mekeel construction. But even if not so admitted, such spacing is obvious and Mekeel himself, in a later patent, described it for Baer's same purpose of allowing for wear between the parts. Mekeel also teaches the relatively heavy spike portion defined in Claim 8 of Baer, in that all of the walls of the Mekeel point are relatively heavy. But even if it did not, no patentable significance can be placed on this element of Claim 8. Baer, in his patent, did not even mention it and furthermore, the same structure is found in other prior art patents for the very same purpose.

The various elements of the Baer structure are all found in the prior art—and all perform the very functions Baer attributed to them. Since, in a combination, the sum must be greater than its various parts in order to find patentability, the Baer patent must fall.

The findings and conclusions of the district court on the validity of the Baer patent are clearly erroneous and must be reversed.

B. The Non-Infringement of the Hensley Points.

Esco has failed to sustain its burden of proving infringement. The Hensley points cannot be lumped together as one typical point but are four different and very distinct configurations. Esco attempted to prove infringement by the Hensley six inch point but its efforts to show the claimed stabilizing function on the four and five inch points have been futile.

Infringement is determined by the *claims* of the patent and if one or more elements of a claim is absent, the accused structure does not infringe.

None of the Hensley points in issue include rearwardly extending tongues with "substantially parallel" side edges as called for in the Baer Claims 8 and 9 and as forcefully urged to be important when the Baer patent was being prosecuted before the Patent Office. Rather, the Hensley tongues more closely resemble the wedge shaped tongues of the prior art Seal patent. The tongues of the Hensley wear-points, when placed on Esco adaptors, do not "fit" into the recesses on the adaptor as called for in the claims, but rather there are distinct spaces or gaps between the tongues and the recesses.

Moreover, the Hensley points do not perform in the same way as the points defined in Baer claims 8 and 9. Because of the gaps between the Hensley tongues and the Esco adaptors, the tongues on the Hensley points do not provide stabilization when the point is used. The Esco test to show such stabilization on the six inch Hensley point is of little or no merit because of the extreme variation between the impact applied during the test and the impact which Esco itself considered "normal".

With respect to infringement, too, the findings and conclusions of the district court are clearly erroneous and must be set aside.

ARGUMENT

A. THE BAER PATENT IS INVALID BECAUSE IT TEACHES NOTHING MORE THAN WHAT WAS ALREADY KNOWN IN THE PRIOR ART.

The validity of a patent is to be tested under two sections of the patent law, 35 U.S.C. §§102 and 103 (1952). The first of these states:

“A person shall be entitled to a patent unless—
 . . . (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . .”

Section 103 of the patent law states:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains . . .”

As recently stated by the Supreme Court referring to these two sections of the statute along with Section 101:

“An analysis of the structure of these three sections indicates that patentability is dependent upon three explicit conditions: novelty and utility as articulated and defined in Section 101, and Section

102, and nonobviousness, the new statutory formulation, as set out in Section 103.”

Graham v. John Deere Co., 15 L.Ed.2d 545, 553.

The Baer patent is invalid under both sections 102 and 103 as set forth below.

1. The Statutory Presumption of Validity Has Been Completely Overcome Because the Patent Office Failed to Consider the Most Pertinent Prior Art.

Upon issuance of the Baer patent on September 27, 1949, it acquired a statutory presumption of validity. 35 U.S.C. §282 (1952) amended 79 Stat. 261 (1965).

The presumption, however, is at best a rebuttable one, even in that situation where the district court has before it only the prior art considered in the Patent Office itself. *Kwikset Locks v. Hillgren*, 210 F.2d 483 (9th Cir. 1954).

In the instant case the Patent Office Examiner did not consider the Mekeel '677 patent (Def. Ex. BB) nor the Mekeel '988 patent (Def. Ex. QQ). The first of these, the Mekeel '677 patent was conceded by the district court to be the most pertinent reference against the Baer patent in suit (Clk. Tr. 489). When the most pertinent prior art, as here, was not considered by the Patent Office, the presumption of patent validity is nil. As stated by this Court in *Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp.*, 287 F.2d 228, 229 (9th Cir. 1961):

“Generally, the action of the Patent Office in allowing the patent creates a presumption of validity. However, even one prior art reference which has not been considered by the Patent Office may overthrow this presumption . . . (citing cases). When the most pertinent art has not been brought to the attention of

the administrative body the presumption is largely dissipated.”

In summary then, the Baer patent in suit reaches this Court completely denuded of any statutory presumption as to its validity. *Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 191 F.2d 632 (9th Cir. 1951); *Gomez v. Granat Bros.*, 177 F.2d 266 (9th Cir. 1949).

2. The Commercial Success of the Esco Wear-Points Cannot Lend Validity to Claims 8 and 9 of the Baer Patent Because the Esco Points Are Not In Accordance with These Claims and Furthermore Commercial Success Alone Is Not Patentable.

Esco manufactures and sells two part excavating teeth including an adaptor and a wear-point under Esco Model Nos. R-4, R-5, R-6 and R-7. These particular points have been commercially successful and, in fact, it is because of Hensley’s manufacture and sale of the expendable and replaceable wear-point portion of these teeth that Esco has charged infringement.

Esco also manufactures and sells additional excavating teeth bearing the Model Nos. R-3 and R-34S and Caterpillar No. 2K4678 (Rep. Tr. 227, 228). All of these Esco teeth are marked with the notice of the Baer patent in suit (Rep. Tr. 227, 228). Despite the fact that all of these Esco points bear the number of the patent in suit, Esco’s own witness admitted that there is no common feature of the points which would tend to make them commercially successful (Rep. Tr. 228, 229). The fact that the Esco teeth were commercially successful could stem from a number of reasons other than the merits of the patented tooth. It is significant, for example, that Esco’s commer-

cial success commenced shortly after World War II, at the beginning of a large highway building program (Rep. Tr. 310).

Despite Esco's allegations of commercial success as to its Models R-4, R-5, R-6 and R-7, none of these commercially successful points were shown to the trial court. Esco's only showing at the trial of a commercial Esco excavating tooth (of the R-4, R-5, R-6 or R-7 type) was in the form of a drawing of an Esco *adaptor* (Pl. Ex. 25), with penciled sketches showing the relationship of the tongues and recesses. But even from this drawing it is obvious that the rearwardly extending tongues of the Esco wear-points do not include upper and lower *parallel* surfaces. The trial court had no evidence before it upon which to base its finding that the "Baer-type excavating teeth"—particularly in accordance with Claims 8 and 9—"enjoyed an immediate and widespread commercial success" (Clk. Tr. 488).

Moreover, to test the Hensley wear-points in comparison with its patented wear-point, Esco had to specially build a wear-point as shown in the Baer patent for use in its tests (Rep. Tr. 58, 62). Furthermore, Esco had to specially grind an adaptor for use in these same tests (Rep. Tr. 105).

The plain fact is that the teeth actually manufactured by Esco do not conform to the teachings of the Baer patent in suit. The teeth claimed in the Baer patent, particularly Claims 8 and 9, have never been shown by Esco to be commercially successful.

But even if commercial success were proved, the patent would still be invalid. In commenting upon the use of

commercial success to validate a patent the Supreme Court in its recent decision in *Graham v. John Deere Co.*, 15 L.Ed.2d 545, 566 (1966), first noted that:

“Cook Chemical insists, however, that the development of a workable shipper-sprayer eluded Calmar, who had long and unsuccessfully sought to solve the problem. And, further, that the long-felt need in the industry for a device such as Scoggin’s together with its wide commercial success supports its patentability. These legal inferences of subtests do focus attention on economic and motivational rather than technical issues and are, therefore, more susceptible to judicial treatment than are the highly technical facts often present in patent litigation. (citing authorities) Such inquiries may lend a helping hand to the judiciary which, as Mr. Justice Frankfurter observed, is most ill-fitted to discharge the technological duties cast upon it by patent litigation. (citing cases) They may also serve to ‘guard against slipping into hindsight’, (citing cases) and to resist the temptation to read into the prior art the teachings of the invention in issue.”

But then went on to explicitly hold:

“However, these factors do not, in the circumstances of this case, tip the scales of patentability.”

The authorities are clear that commercial success cannot validate a patent. *Monroe Auto Equipment Co. v. Superior Industries Inc.*, 332 F.2d 473 (9th Cir. 1964); *Farr Co. v. American Air Filter Co.*, 318 F.2d 500 (9th Cir. 1963). This is particularly so, as here, when there is no evidence that the success was attributable to the features or structures patented. *Heath v. Frankel*, 153 F.2d 369 (9th Cir. 1946).

3. The Effect of the Mekeel '677 Patent as Prior Art Cannot be Diluted by Labeling It a Paper Patent—Esco Itself Has Given Mekeel Commercial Utility.

The trial court placed great emphasis on the allegation that the Mekeel '677 patent (Def. Ex. BB) was not adopted by the art and consequently was not subjected to the tests of actual usage (Clk. Tr. 489, 494, 495, 496). This is clearly a misplaced emphasis in view of the Supreme Court's recent statement on the relevancy of prior art not actually used. In *Graham v. John Deere Co.*, 15 L.Ed.2d 545, 567 (1966), the Court held:

“It is also irrelevant that no one apparently chose to avail themselves of knowledge stored in the Patent Office and readily available by the simple expedient of conducting a patent search—a prudent and nowadays common preliminary to well organized research.”

But aside from the misplaced emphasis, the trial court has clearly erred on the facts. The Mekeel '677 patent, at least the wear-point shown and described in that patent, has been commercially used by Esco itself. In this regard, it should be remembered that only the wear-point is involved in Esco's charge of infringement on Claims 8 and 9 of the Baer patent.

Esco manufactures and sells a wear-point identified as Model No. R-34s (Def. Ex. B) which cooperates with the Esco adaptor No. WRR-34 (Def. Ex. C). A visual comparison of the Esco R-34S point with Figure 8 of the Mekeel '677 patent (Def. Ex. BB) makes it obvious that the wear-point taught by Mekeel has been used. Moreover, the actual use of this structure has been by Esco itself.

The Esco adaptor WRR-34 (Def. Ex. C) does not appear identical to the adaptor shown in Figure 9 of the

Mekeel '677 patent (Def. Ex. BB). Referring to the Mekeel '677 patent it can be seen that the nose of the adaptor is split to form a tenon, whereas the nose of the Esco adaptor is not. But, as noted above, the claims here in suit, Claims 8 and 9 of the Baer patent relate only to the *wear-point* and not to the adaptor nor to the combination of the wear-point and adaptor.

The conclusion is inescapable that the Esco R-34S wear-point is the same as that shown in Figure 8 of the Mekeel '677 patent. The structure of the Mekeel '677 patent *was* recognized and used by the industry and by Esco itself. Mekeel '677 is not a paper patent.

4. **The Teachings of the Baer Patent Are the Same As Those in the Mekeel '677 Patent and Baer Is Therefore Invalid.**
 - a. **The Alleged Differences of Baer are Actually Nonexistent.**

During the course of this litigation in the district court, Esco has urged three features as being the major distinctions between the Baer and Mekeel structures as they relate to Claims 8 and 9. These three features include: 1. the reversal of the tongues and recesses by Baer's putting the tongues on the point and the recesses on the adaptor, rather than the reverse as shown in the Mekeel '677 patent; 2. heavier upper spike portion of the Baer point (Claim 8 only); and 3. spacing between the parts of the wear-point and the adaptor.

It has also been contended that the Mekeel '677 patent cannot anticipate Baer because Mekeel's wear-point is symmetrical or reversible (can be turned upside down on the adaptor) and Baer's is not. However, Esco's own expert witness, Dr. Graf, refutes this contention with re-

spect to Mekeel. Relative to the reversibility of the Baer and Mekeel teeth, Dr. Graf stated:

“Well, in the Baer construction, the top surface—these are not reversible teeth in the Baer and they are not in this either.

Mr. Fallon: They are not in this?

The Witness: They aren't, are they?

I don't think they are. According to this drawing, it's not symmetrical, so this point is not symmetrical, so I would judge they are not intended to be reversible. However, I don't know . . .” (Rep. Tr. 581, 582).

Moreover, the Baer patent does not anywhere indicate that it is directed specifically to a non-reversible point. In fact, one of the commercial wear-points (Def. Ex. D) which Esco has marked with the Baer patent number, is of the reversible type—the point can be turned upside down on the adaptor. Such reversibility was admitted by plaintiff's witness, Mr. Eyolfson, when confronted with an actual demonstration in court (Rep. Tr. 661, 662). It should also be recognized that reversibility is not mentioned in either of the claims here involved.

i. The Equivalence of Reversed Tongues and Recesses Is Found Not Only on the Face of the Mekeel '677 Patent but Also By Esco's Own Witnesses.

Claim 8 of the Baer patent recites inferentially that the adaptor portion of the tooth should include recesses extending from the side faces. Claim 8 also recites affirmatively that the wear point portion of the tooth includes “integral projecting tongues thereon adjacent the open end of the socket,”. The Mekeel '677 patent does not show a wear-point with extending tongues but rather the wear-

point as shown in Figure 8 of Mekeel includes recesses at the rear thereof which cooperate with mating tongues on the adaptor. This, of course, is the exact reverse of what is shown in the Baer patent. But the teaching of the Mekeel '677 patent is far broader than the mere showing in the drawing. Particularly, the Mekeel specification states:

“In this modification of the invention I have likewise shown an additional feature which may be included in the assembly, whether of the form shown in Figures 1 to 6 inclusive, or of the form shown in Figures 7 to 10 inclusive. This consists of tongues formed in *one member* of the assembly, which project beyond the plane of the case of the point and are engaged in a recess in the *other member* of the assembly. *As illustrated*, this consists of tongues 23,23 formed on the sides of the nose 16a and engaging in suitable recesses 24,24, formed in the sides of the point at the base thereof. *This construction adds rigidity to the connection of the parts.*”

(Def. Ex. BB, p. 2, ll. 77-91) (emphasis added)

It is clear then that the Mekeel '677 patent places no special significance on the tongues being on either the point or the adaptor. Also the tongues and recesses of Mekeel are for the same purpose as in Baer.

This interlocation of tongues and recesses is not only disclosed in the Mekeel '677 patent, but it has been indicated by Esco to be within the scope of the claims of the Baer patent. While the Baer patent speaks only of rearwardly extending tongues on the wear-point, Esco has clearly shown that its interpretation of the Baer patent includes not only tongues on the wear-point but also

recesses on the wear-point for receiving forwardly extending tongues on the adaptor.

As mentioned above, Esco itself manufactured and sells a wear-point R-34S (Def. Ex. B) which it marks with the number of the Baer patent in suit, number 2,483,032. The R-34S point (Def. Ex. B) does not have the extending tongues shown in the Baer patent; but rather, it has recesses for receiving the forwardly extending tongues of a cooperating adaptor (Def. Ex. C) (Rep. Tr. 592). In order to justify the patent marking on the R-34S, it has been urged that this point is covered by Claim 5 of the patent (Rep. Tr. 284).

Among other elements, Claim 5 calls for “*additional means* stabilizing the tooth point relative to the adaptor in the direction laterally of the nose” (emphasis supplied).

The patent law states:

“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification *and equivalents thereof*.”

35 U.S.C. § 112 (1952) (emphasis supplied)

In the Baer patent, the only “additional means” of support are the rearwardly extending tongues with parallel edges fitting snugly into the recesses of the adaptor as shown in the drawings of the Baer patent (Rep. Tr. 241).

On cross-examination, Esco’s witness, Mr. Wilcox, stated that the various equivalents of this “additional

means'' includes the reverse structure; that is, recesses on the point and tongues on the adaptor (Rep. Tr. 248, 249). In addition, Esco's expert witness, Dr. Graf, testified that the distinction between the reversed form of tongues and recesses is only a matter of degree (Rep. Tr. 591, 592).

Referring to the tongues and recesses in his '677 patent, Mekeel states:

''This construction adds rigidity to the connection of the parts.'' (Def. Ex. BB, p. 2, ll. 90, 91)

In addition, Hensley's expert witness, Mr. Foster, likewise testified that the reversal of tongues and recesses between the point and the adaptor is merely a matter of degree and that in either case stabilization is provided (Rep. Tr. 480, 481).

In view of the statements in the Mekeel patent itself, in view of Esco's patent marking on the R-34S wear-point, in view of the statements made by Esco's own witnesses, Mr. Wilcox and Dr. Graf, and in view of the testimony of Hensley's witness, Mr. Foster; it is clear that, contrary to the finding of the district court (Clk. Tr. 493, 495), the rearwardly extending tongues of Mekeel do supply the additional stabilizing support and are the full equivalent of the tongues and recesses of the Baer patent.

Actually the district court's finding is based upon a clear misreading of the testimony. The court, at page 495 of the clerk's transcript, quotes the testimony of Mr. Paul Eyolfson at page 630 of the reporter's transcript which quote is as follows:

''The Court: In other words, you tell me there is no stabilizing effect there.

“The Witness: That’s right and what’s even more important is that once that thing moved forward in any degree it could not return because the thing would have seized tremendously. . . .”

Immediately following this quotation, the district court states:

“The basic teaching of Mekeel is entirely different from that of Baer. Mekeel does not rely on tongues for additional stablization, since a rigid lock is brought about by the expanded tenon which provides the connection between the point and the adapter.”

But the quoted portion of Mr. Eyolfson’s testimony *was not related to the tongues and recesses at all*. Rather the quoted portion of Mr. Eyolfson’s testimony related to frictional contact between the sides of the Mekeel adaptor nose and the inner-sides of the Mekeel point. Referring to the full testimony of Mr. Eyolfson on this point (from page 628 of the reporter’s transcript), this is made abundantly clear:

“... be that as it may, you can get it together, and I am assuming that the inventor here (Mekeel) is attempting to keep the upper and lower bearing surfaces in contact, and then by spreading this apart, also keep the side surfaces in contact in the initial situation. Now the side surfaces, if you put a transverse force on here, downward like so, the side surfaces, being virtually up and down, will have no effect on stopping vertical motion. Even though, even with the friction. And if you do that and allow a force to build up on the angular surfaces on the nose itself, you will have a tendency for that point to come forward, resisted by its own friction, and resisted by the side friction only on these two sides—since

the pin in the other views of this does not contact the nose or the point—I mean not the point at all—it only spreads apart the nose.

“You will actually strip this deal off—either you will explode that point if the material is ductile enough, you will deform it—

“The Court: In other words, you tell me there is no stabilizing effect there.

“The Witness: That’s right, and what’s even more important is that once that thing moved forward in any degree it could not return because the thing would have seized tremendously.”

There is no evidence at all to support the court’s finding that Mekeel does not rely on tongues for additional stabilization. Rather, there is preponderant evidence to the contrary. Consequently, it must be found that the Mekeel patent teaches the tongue and recess combination for the very purpose taught by Baer and further, that the particular embodiment shown by Mekeel with the recesses on the point and tongues on the adaptor, is the full equivalent of that shown and claimed by Baer with the tongues on the point and the recesses on the adaptor. The only difference is a mere matter of degree which is in and of itself not patentable. *Smith v. Nichols*, 88 U.S. (21 Wall.) 112 (1874); *Lovell Mfg. Co. v. Cary*, 147 U.S. 623 (1893); *Pierce v. Ben-Ko-Matic Inc.*, 310 F.2d 475 (9th Cir. 1962).

It is well established that the mere reversal of parts is not invention when the parts reversed serve the very same purpose. *Ronning Mach. Co. v. Caterpillar Tractor Co.*, 129 F.2d 70 (7th Cir. 1942); *Murray-Ohio Mfg. Co. v. E. C. Brown Co.*, 124 F.2d 426 (6th Cir. 1942); 2 DELLER’S

WALKER ON PATENTS, § 121, 2d ed. Without question, the purpose of the tongues and recesses in Mekeel (in the words of Mekeel himself) is to add “rigidity to the connection of the parts” (Def. Ex. BB, p. 2, ll. 90, 91). This is identical to the stated purpose of the Baer tongues and recesses which (in the words of Baer) is “to improve the lateral stability of the tooth point with respect to the adapter as well as to prevent relative movement or creeping between the tooth point and the adapter” (Pl. Ex. 1, col. 3, ll. 5-8).

Although the construction as shown in the Baer patent is possibly a better, more polished, embodiment of the original Mekeel invention, such mere carrying forward of Mekeel’s original thought, improving only the result, is not patentable. *Railroad Supply Co. v. Elyria Iron & Steel Co.*, 244 U.S. 285 (1917); *Market Street Cable Railway Co. v. Rowley*, 155 U.S. 621, 629 (1895); *Roberts v. Rider*, 91 U.S. 150, 159 (1875); *Willamette-Hyster Co. v. Pacific Car & Foundry Co.*, 122 F.2d 492 (9th Cir. 1941).

ii. **The Relatively Heavy Spike Portion of Claim 8 is Found in Mekeel as Clearly as in the Baer Patent.**

Claim 8 (but not Claim 9) of the Baer patent recites that the wear-point includes “a spike portion of *relatively heavy section*”. During the course of the trial, considerable importance was placed by Esco on the designation of the spike portion as being of heavy section. Esco’s witness, Mr. Eyolfson, at pages 623 through 626 of the reporter’s transcript defined the differences between the Baer wear-point and that as taught by Mekeel in terms of the importance of a heavy spike portion.

This testimony at trial was to the effect that it was advantageous to have the spike portion *heavy* so as to transfer the load from the tip of the wear-point to the tongues (Rep. Tr. 623, 624) but there is no evidence at all as to why the spike portion should be *heavier* than the other portions of the point.

The Baer patent, although *showing* the top portion of the point thicker than the lower in Figures 3 and 9, makes no mention in the descriptive portion thereof to the effect that the upper portion is thicker than the lower portion. As noted previously, the spike portion (numbered 43 in the drawings of the Baer patent) is mentioned in the descriptive portion at least nine times but in each case, it is referred to merely as a “spike portion”. No where is there any indication that it is to be relatively heavy. Clearly Baer placed no particular importance on the spike portion being heavier than any other portion of his tooth point.

The district court held that:

“Mekeel does not provide the second coactive feature of Baer, the heavy upper spike portion of the point. . . . The upper and lower faces (if there is a true upper and lower face to a reversible point) and the sides of the Mekeel point appear to be of the same thickness. . . . Hence, neither this feature nor the equivalent thereof appear in Mekeel. The fact that a heavy upper spike portion of the tooth appeared in other prior patents which did not provide the other coactive elements of Baer does not void the Baer patent. The absence of this spiked portion of the Baer patent alone is sufficient to defeat defendant’s claim that Mekeel anticipated Baer.” (emphasis in original)

(Clk. Tr. 494)

The court held that Mekeel does not have a heavy upper spike portion; but it should be realized that the claim does not call for a relatively heavy *upper* spike portion. The claim calls for a spike portion of relatively heavy section. No where in the specification or claims of the Baer patent is it recited that it is the "upper" portion of the point which is of relatively heavy section. Moreover, there is no indication throughout the entire patent that, if the spike portion is of relatively heavy section, it should be heavy relative to some other portion of the wear-point. There is no indication in the entire patent from which it can be concluded that the upper portion, or the spike portion, as shown in Baer, must be heavy relative to the side portions, to the lower portions of the point, or to some other portion of the entire tooth.

While it is possible to use expert testimony to clarify ambiguous portions of the patent claim, the claim cannot be construed to include what is beyond its clear language. *Burns v. Meyer*, 100 U.S. 671 (1879); *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U.S. 399 (1905). Neither the claims nor the Baer patent specification give any indication as to what the spike portion is heavy relative to.

Even if the language of Claim 8 relating to the relatively heavy section were to be interpreted as plaintiff has suggested at trial, it would not add patentability to the Baer structure. Esco's own expert witness, Mr. Eyolfson testified that it was within the skill of the art. The exact testimony is as follows:

"The Court: Well, isn't that something that would be apparent to anyone familiar with the art?

“The Witness: Well, sure.

“The Court: Any mechanical engineer would know that?

“The Witness: Any mechanical engineer knows if he wants to stiffen up a beam, you could do that.”

(Rep. Tr. 624)

There was also other evidence that such thickening of the upper wall of a point was, in and of itself, well known and in common practice at the time of Baer's patent application. The thickened upper wall is shown, for instance, in the prior art, Hosmer, Crawford and White patents (Def. Exs. S, V and W).

Moreover, all of the walls of the wear-point shown in Figure 8 of the Mekeel '677 patent (Def. Ex. BB) are of relatively heavy section (Rep. Tr. 473). In fact, the entire point is relatively heavy. The obvious thickening of the spike portion is not inventive, 35 U.S.C. § 103 (1952); *Graham v. John Deere Co.*, 15 L.Ed. 2d 545.

iii. The Spacing Between Wear-Point and Adaptor is Inherent As Well As Obvious.

Both Claims 8 and 9 of the Baer patent refer inferentially to a spacing between the wear-point and the adaptor. As stated in the specification of the Baer patent, the reasoning for this spacing is to allow for wear and the effects of impact against the tooth point (Pl. Ex. 2, col. 3, l. 60). Esco's expert witness, Dr. Graf, recognized that such spacing is inherent in the Mekeel structure and would occur whether intentional or not. As stated by Dr. Graf, “Well, I am pretty sure that in any case there would be some spacing, considering ordinary casting toler-

ances. Whether it is intentional or not, I don't know." (Rep. Tr. 583).

Moreover, Mekeel himself, recognized the utility of this spacing in teeth of the type described in his first patent—the Mekeel '677 patent (Def. Ex. BB). In his second patent, the Mekeel '988 patent, he stated:

"The digging or dipper tooth, as shown herein, is of the two-part, reversible type, consisting of a point and of a [adaptor] . . . and is of the kind described in my pending application Serial No. 345,719 filed March 9, 1929, now patent No. 1,845,677; (Def. Ex. BB)—That is to say, it is a digging tooth including a part having a socket and a part having a slotted tenon engaged in said socket with means for expanding the tenon in the socket to lock the two parts together." (Def. Ex. QQ, p. 1, ll. 5-14).

"The angle of the converging engaging faces 17, 17 and 19, 19 of the point and [adaptor] . . . are so designed that when the tenon 12 is completely inserted into the socket 15 in the [adaptor] . . ., the ends 21 of the projections or nibs 18 terminate short of the bottoms 22 of the recesses 16 in the point and the rear end 23 of the point is spaced from the shoulders 20 on the [adaptor]. . . . Thus the thrust engagement between the [adaptor] . . . and point,—that is to say, between the two parts of the digging tooth, is provided entirely by the engagement of the faces 17 and 19, respectively, of the recesses 16 in the point and of the nibs or projections 18 of the [adaptor]. . . . By this means *any wear on the contacting parts will be taken up and compensated for by further driving the [point] . . . towards the [adaptor] . . . with no possibility of the shoulders 20 or the ends of the projections 18 engaging and thereby limiting that movement.*" (Def. Ex. QQ, p. 1, ll. 79-98).

The utility and advantage of spacing, as recognized by Mekeel, was the same as that recognized by Baer in his subsequent patent (Pl. Ex. 2).

Moreover, this same spacing was found in the other two part excavating teeth as shown by the prior art to McKee, Crawford, Hosmer and British patents (Def. Exs. AA, V, S and DD).

But even if the spacing between point and adaptor were to be considered a patentable feature of Baer—*it is a feature of the combination of the point and adaptor*—not of the point alone. Hensley only sells (and Baer Claims 8 and 9 are only directed to) the point alone. Logic demands that the features of the combination cannot be used to add patentability to the point alone.

As a final blow to Esco's stress on the importance of this spacing, the district court found:

“If the other features of Baer were present in Mekeel, this specification might not be too important in view of the testimony of plaintiff's expert that spacing would arise from usual manufacturing tolerances.” (Clk. Tr. 494).

b. The Baer Aggregation of Old Elements Is Not Patentable Since Each Element Only Provides Its Obvious Function.

The trial court held:

“With relation to the three major and distinctive features relied upon by plaintiff in support of Claims 8 and 9, defendant contends that each feature is old and may be found in the prior art, as exemplified in various patents introduced in evidence through its witness, Dirks Foster. That each of these features, if considered separately, may be said to have been anticipated by the prior art, exemplified by patents

offered in evidence seems clear, but the big and narrower question is, do these features operate independently of each other or are they so coactive as to bring a new and useful result.” (Clk. Tr. 490).

In order for a combination of elements to be patentable, the combination must provide more than the separate functions of the individual elements. *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Co.*, 340 U.S. 147 (1950); *Rohr Aircraft Corp. v. Rubber Teck Inc.*, 266 F.2d 613 (9th Cir. 1959). Stated in other words “[t]here is no invention in a ‘mere aggregation of a number of old parts or elements’, nor in the *accumulation* of old devices which do not in some way exceed ‘the sum of its parts’”. *Kwikset Locks v. Hillgren*, 210 F.2d 483, 486 (9th Cir. 1954 [Footnote omitted—emphasis in original].

The three features relied upon by plaintiff are the use of tongues on the point and recesses on the adaptor, a heavy upper wall on the wear-point, and spacing between the wear-point and the adaptor.

The function provided by the tongues and recesses of the Baer patent is set forth in the Baer patent (Pl. Ex. 2) at column 3, lines 4 to 7:

“... the tongues 48 are provided on the tooth point 42 to improve the lateral stability of the tooth point with respect to the adapter as well as to prevent relative movement or creeping between the tooth point and the adapter, ...”

This same function is attributed to the tongue and recess combination as shown from the Mekeel patent. Mekeel states: “This construction adds rigidity to the connection of the parts”. (Def. Ex. BB, p. 2, ll. 90, 91).

The second alleged feature of the Baer patent is the heavy upper wall or spike portion. No function is attributed to this heavy section in the Baer patent but Esco's witness, Mr. Eyolfson, testified that the purpose is to transmit forces back to the tongues where they are resisted (Rep. Tr. 199). The same function is attributed to the heavy spike or body shown in the Hosmer patent (Def. Ex. S). Referring to the spike, Hosmer states:

"The [spike] . . . 22 overlies and directly bears on the upper surface 16 of the [nose] . . . 13 when downward loads are imposed on the tooth point. The tang 26 engaging in the opening 19 effectively resists forces on the [spike] . . . 22 that tend to lift or tip the body upwardly with respect to the [nose] . . . 13" (Def. Ex. S, p. 3, col. 1, ll. 35-43).

Also, as stated by Esco's witness, Mr. Eyolfson with respect to the heavy spike portion:

"Any mechanical engineer knows if you want to stiffen up a beam, you can do that." (Rep. Tr. 624).

Here again, the normal, usual function of the element is employed.

The third feature of the Baer patent is the spacing between the wear point and the adaptor and that purpose as set forth in the Baer patent is "to allow for wear and the effects of impact against a tooth point in use" (Pl. Ex. 2, col. 3, ll. 60, 61). This same function of spacing between the wear-point and the adaptor is taught in the Mekeel '988 patent (Def. Ex. QQ). As noted previously, Mekeel states:

"By this means any wear on the contacting parts will be taken up and compensated for by further driving the tooth towards the base with no possi-

bility of the shoulders 20 or the ends of the projections 18 engaging and thereby limiting that movement.” (Def. Ex. QQ, p. 1, ll. 93-98)

Thus, not only are the individual elements of the Baer patent found in the prior art but their identical functions are likewise found. The overall function of the structure shown in the Baer patent is nothing more than the aggregation of these different functions. The tongues and recesses provide support; the heavy upper wall or spike provides sufficient strength to transfer forces; and spacing between the point and the adaptor permits the parts to remain in engagement even after wear. Neither the elements nor their function is new.

B. HENSLEY WEAR POINTS DO NOT CONFORM TO THE CLAIMS OF THE BAER PATENT AND THEREFORE DO NOT INFRINGE.

1. Esco Has the Burden of Proving Infringement of Its Patent Claims 8 and 9.

In a patent infringement action, the burden of proving infringement rests with the patentee, plaintiff. *Bates v. Coe*, 98 U.S. 31, 49 (1878); *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 151 F.2d 91 (9th Cir. 1945). There are four different Hensley points in contest—the four inch (Pl. Ex. 5), the five inch (Def. Ex. J), the six inch (Pl. Ex. 10) and the seven inch (Pl. Ex. 32). These points are known as R-4HX, R-5HX, R-6HX and 7-RHX, respectively.

Each of the Hensley points is different not only in size but in the configuration of the rearwardly extending tongues. The upper and lower edges of the four inch

point (Pl. Ex. 5) are clearly not parallel, as can be seen by visual observation. During the course of the trial these edges were measured to be at an angle of about 60° (Rep. Tr. 352). The six inch size (Pl. Ex. 10) likewise include upper and lower edges which are not parallel and which at the trial were measured to be about 35° . This non-parallelism can also be seen in the drawing (Pl. Ex. 25) showing in pencil the outline of the tongues on the Hensley R-6HX points. Although the angle of the upper and lower edges were not measured at trial with respect to the R-5HX (Def. Ex. J), it is apparent from visual observation that this angle is somewhat between that of the R-4HX and the R-6HX (Pl. Ex. 5 and 10). At the trial the upper and lower edges of the Hensley R-7HX were measured to be something between five and fifteen degrees (Rep. Tr. 665-667).

Not only are the rearwardly extending tongues different for each of the Hensley wear points but also their operation is different. Esco, in its efforts to show infringement, performed a series of tests on the Hensley R-6HX points (Pl. Exs. 9 and 10) which tests, to Esco's satisfaction at least, showed that the rearwardly extending tongues on the six inch Hensley points provided the additional stabilization as called for in the Baer patent.

Although Esco had attempted to perform the same tests on the smaller four and five inch Hensley points, it was unable to show any support as called for in the Baer patent. The testimony of Esco's witness Mr. Eyolfson is as follows in this respect:

“Mr. Herbert: Q. Did you testify that you tried to place in a guillotine test Hensley R-4 and Hensley R-5 points?

"A. Yes, I did at one time a number of years ago. I mean two or three years ago at least.

"Q. The tests were not satisfactory?

"A. Not too satisfactory.

"Q. In that they did not make contact?

"A. No, in that the points just shattered.

"Q. Did they make contact?

"A. Sure.

"Q. Upon shattering?

"A. Who's to say?

"Q. I am asking. You made the tests.

"A. Well, if you saw what it is, when you close it up and you hit it and you look at what's there when you get through, they were shattered and there was contact made. It doesn't establish anything other than the fact that contact was made. The points were broken.

"Q. But contact only with the points broken?

"A. I don't know. I wasn't able to test one that didn't break." (Rep. Tr. 663, 664)

Moreover, the district court found that:

"While the sides of tongues on the smaller sized Hensley-Esco type points may or may not be said to be substantially parallel, the sides of the tongues on the larger, seven inch, sized Hensley-Esco type points appear to be as close to substantially parallel as measurement could provide." (Clk. Tr. 484)

The court then went on to say:

"This may well account for defendant's attempt to avoid infringement by foregoing certain initial stages of stabilization in its smaller size points where added stabilization may not be needed as often. A somewhat less efficient operation does not avoid infringement." (Clk. Tr. 486)

In commenting on the tests offered by both Esco and Hensley the court again referred to Hensley's smaller sized points and stated:

“Furthermore, the Hensley tests, which were *in the main made on smaller sized points* (where the additional stabilization effect has lesser importance), were variable and impossible to evaluate.” (emphasis supplied) (Clk. Tr. 485)

Hensley's tests were *not* “in the main made on smaller sized points” but actually included the six inch size which is the only point Esco was able to test to its satisfaction (Rep. Tr. 324). Defendant's Exhibits I, J and K are of the four, five and six inch points, as tested by Hensley.

Despite this recognition of the distinctions between the large and small points, the district court summarized generally on the question of infringement:

“The court is satisfied that the tongues on the Hensley-Esco type points serve the above indicated stabilization purpose and that this is the very reason they were retained.” (Clk. Tr. 486)

With respect to the four, five and seven inch Hensley points, there has been no showing that the feature of “additional stabilization” is provided. Esco's only test to show such stabilization has been with respect to the six inch, R-6HX point. With the clear and obvious differences between the various sized points and the lack of testimony showing infringement by the R-4HX, R-5HX and R-7HX points, Esco has not even attempted to carry its burden in showing infringement of these points. The burden of proof in patent infringement rests with the

plaintiff. *Bates v. Coe*, 98 U.S. 31, 49 (1878); *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 151 F.2d 91 (9th Cir. 1945).

2. In Determining the Question of Patent Infringement the Most Essential Element is the Claims of the Patent and the Baer Claims Do Not Read On the Hensley Points.

The claims of a patent measure the invention. *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405 (1908). In order for a patent to be infringed each element of the claim of the patent must be found in the accused device and the absence of one or more of the material features of the claim avoid infringement. *Lockwood v. Langendorf United Bakeries, Inc.*, 324 F.2d 82 (9th Cir. 1963); *Englehard Ind. Inc. v. Research Instrument Corp.*, 324 F.2d 347 (9th Cir. 1963).

The patent statute requires:

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

35 U.S.C. §112 (1952)

As pointed out by the Supreme Court in *White v. Dunbar*, 119 U.S. 47, 51 (1886):

“Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim;

but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is: and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further.”

The district court based its decision as to infringement on the findings that:

1.) “The defendant’s change in design and construction of its new points is insufficient to avoid its previously admitted infringement of these two claims.” (Clk. Tr. 483)

2.) “The sides of the tongues of the larger, seven inch, sized Hensley-Esco type points appear to be as close to substantially parallel as measurement could provide. Furthermore, Clyde C. Hensley did not deem angle of the sides of the tongue of any significance to him. The above described change is at most a colorable change, and as such it cannot avoid infringement.” (Clk. Tr. 484)

3.) that if, “. . . there was no reason for [Hensley’s] having the rearwardly extending tongues, why did he keep them when he made the change?” (Clk. Tr. 484)

4.) “that both Baer and Hensley-Esco type points operate in the same manner, i.e., the inwardly extending tongues provide a stabilizing function in addition to the wedge faces and thereby protect the pin from deformation and make the point removal simple.” (Clk. Tr. 485)

The only attempt to relate the Hensley points to the claims of the Baer patent appears in the appendix to the district court's opinion (Clk. Tr. 499, 500). This appendix shows only the very broadest comparison of Claims 8 and 9 of the Baer patent with one generalized Hensley wear-point. The district court did not find the various features of the Baer Claims 8 and 9 particularly in the Hensley points, R-4HX, R-5HX, R-6HX or R-7HX and consequently, there can be no infringement. *Lockwood v. Langendorf United Bakeries, Inc.*, 324 F.2d 82 (9th Cir. 1963).

3. The Hensley Wear-Points Do Not Incorporate Essential Elements of Baer Claims 8 or 9.

Claim 8 of the Baer patent recites among other elements that "said tongues having *substantially parallel side edges* adapted to fit into said recesses of the adaptor shank portion when the nose is seated in the socket, thereby to support the tooth on the adaptor in directions transverse to the wedge faces." (emphasis supplied)

The rearwardly extending tongues of the Hensley points are clearly such that their upper and lower edges are *not* parallel. As mentioned hereinabove the angle between the upper and lower edges of the R-4HX is approximately 60° and of the R-6HX is approximately 35° .

In Plaintiff's Exhibit 25 the angle between the faces of the wedge shaped nose of the adaptor is set forth as being 29° 20 minutes. Esco's own expert recognized that this angle of 29° and 20 minutes was not "substantially parallel" (Rep. Tr. 277, 278). If an angle of 29° and 20 minutes is not substantially parallel, it is obvious that the even steeper angles of 35° and 60° are not substan-

tially parallel. As a matter of fact, the angle of 60° between the upper and lower surfaces as shown in the R-4HX is more closely akin to perpendicularity than to parallelism.

It is axiomatic that a patentee in an infringement suit may not take a position inconsistent with the one he maintained before the Patent Office in proceedings which led to the issuance of a patent. *D & H Electric Co. v. M. Stevens Mfg. Inc.*, 233 F.2d 879 (9th Cir. 1956); *Cutter Laboratories Inc. v. Leophile-Cryochem Corp.*, 179 F.2d 80 (9th Cir. 1949). But this is exactly what is necessary in order to find that Hensley type points infringe the Baer patent claims in issue.

In the very paper in which the Baer patent Claims 8 and 9 were presented to the Patent Office, Baer's attorney commented upon the earlier Seal patent (Def. Ex. R) as follows:

"The Examiner has apparently relied upon the disclosure of the Seal patent to indicate the use of tongues on the side of a tooth point. It is to be observed that the side *tongues of Seal would be useless in the applicant's disclosed structure, because they are wedge-shaped and*, consequently, could not be made to maintain engagement for reinforcing purposes during any longitudinal movement of the tooth point relative to the adapter." (Def. Ex. M, p. 37) (emphasis supplied)

Referring to the Seal patent (Def. Ex. R), Figure 1, the wedge-shaped nature of the rearwardly extending tongues is apparent. Esco and Baer then, have admitted that angles as shallow as 29° 20 minutes are wedge shaped and not substantially parallel. Further, they have

admitted that wedge shaped tongues will not work in the Baer excavating tooth. But the findings of the district court require that these admissions and facts be ignored and hold that deviations of as much as 60° are not only "substantially parallel" but also fulfill the function as set forth in the Baer patent. Such holding is clearly contrary to the opinion of this Court in *D & H Electric Co. v. M. Stevens Mfg. Inc.*, 233 F.2d 879 (9th Cir. 1956), where in a situation quite similar to the instant case, a deviation of from 1 to 5 degrees from being "substantially at right angles" was held sufficient to avoid infringement in view of statements made in the Patent Office prosecution. In *D & H Electric*, at 883 it was stated:

"At this time, argument was made on behalf of the applicant (appellants' assignor) that of prime importance in the invention was the fact that the ribs were not convolutions, but were at right angles to the major axis. Prior art had ribs arranged as convolutions in screw threads, either continuous or interrupted, and the file wrapper shows that applicant strongly delineated between such screw threads and the ribs of his device."

and at 884:

"This case is complicated by the striking similarity of the patent in suit and the appellees' device, much of which of course is dictated by the limited function performed by the devices. Shape and dimensions are substantially, if not exactly, the same, the sole difference being that the angle of the ribs of appellants' device is 90° to the major axis, while the projections of the appellees' device vary from 85° to 89° to the major axis. Slight as this difference

may seem, it invokes an entirely different principle of operation. By reason of their right angularity, the ribs of appellants' device are not and cannot be considered screw threads, while it is equally obvious that by their 1° to 5° variation, the projections of appellees' device can be nothing other than interrupted screw threads. Thus, as pointed out in appellees' brief, the purpose of the accused device is to more or less *fit* the conduit, while the purpose of the patent in suit is to misfit the conduit in affecting the coupling." (emphasis in original)

Claims 8 and 9 also require and recite that the rearwardly extending tongues are "adapted to fit" into the recesses of the adaptor. Although this fitting together of the wear-point and adaptor is, in reality, an element of the combination of point and adaptor (Claims 8 and 9 are directed to the wear point alone) this too was heavily relied upon by Baer during the Patent Office prosecution.

In support of patent Claims 8 and 9, Baer's attorney stated:

"It is further to be noted that the side tongues on the tooth point are of a length such that they do not normally seat at the ends of the recess in the adapter shank. Thus, while the tooth point may move longitudinally of the adapter nose to maintain seating engagement of the wedge surfaces, the parallel edges of the *tongues remain in engagement* with the edges of the recess without interfering with the longitudinal seating of the tooth point on the adapter nose.

"The three claims now under consideration are particularly devoted to a tooth point *having specific structural details for effecting the maintenance of*

the seating engagement between the co-acting wedge and tongue surfaces of an adaptor, so that the aforementioned advantages are attained." (emphasis added) (Def. Ex. M, p. 36)

This fitting relationship between the point and the adaptor was added only after the Patent Office had refused to allow claims without such relationship. Patent application Claims 6 and 7 (Def. Ex. M, p. 14) did not refer to the adaptor at all. But even after repeated attempts to obtain allowance of Claims 6 and 7, they were finally canceled and new claims were added. The new claims recited the "fitting" relationship and eventually issued as patent Claims 8 and 9 here in issue.

Where the broad claims in a patent application are limited by amendment during the course of prosecution, the claims allowed in the patent cannot be construed to cover that which the amendment eliminated from the patent. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1941); *Schriber Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211 (1940); *Moon v. Cabot Shops*, 270 F.2d 539 (9th Cir. 1959).

Baer having defined what he means by the fitting relationship of the tongues and recesses and having urged this interpretation on the Patent Office, Esco cannot now broaden the scope of the claims beyond that originally urged on the Patent Office.

Thus the Baer patent Claims 8 and 9 require fitting relationship between the tongues of the wear-point and the recesses of the adaptor. This relationship is not present in the Hensley points and there has been no showing of such interfitting relationship. In fact, the evidence

showed that there was actually a space between the rearwardly extending tongues of the Hensley points and the recesses in the Esco adaptor (Rep. Tr. 178, 344).

The Hensley points not having rearwardly extending tongues which have “substantially parallel” upper and lower edges and which “fit” into the recesses of the adaptor—no infringement can be found.

4. Hensley Wear Points Do Not Infringe Because They Do Not Have Tongues and Recesses Which Provide Support.

The mere finding that every element of a claim exists in an accused device (and this has not been found here) is not, in and of itself, determinative of the question of infringement. In the words of this Court in *Grant v. Koppl*, 99 F.2d 106, 110 (9th Cir. 1938):

“We note that appellant contends that the claims of the patent in suit read upon appellee’s device. . . . But infringement is not a mere matter of words.”

Before infringement is proved, it must be shown that the accused device must utilize substantially the same structure, operating in substantially the same way to produce substantially the same result as the structure of the patent. *Pursche v. Atlas Scraper & Eng’r Co.*, 300 F.2d 467 (9th Cir. 1961); *Filtex Corp. v. Amen Atiyeh*, 216 F.2d 443 (9th Cir. 1954).

Esco has conceded this in admitting that without support between the tongue and recess there is no infringement (Rep. Tr. 453). It must then prove that support exists.

Such identity of function has not been shown by Esco. With respect to the four, five and seven inch Hensley

points, Esco has not offered any testimony at all on the stabilizing function of the tongues.

With respect to the Hensley six inch points the only evidence offered by Esco is its *laboratory* tests wherein the forces applied were magnified three times greater than those actually encountered in usage. Esco's expert on the laboratory test, Mr. Eyolfson, testified that six thousand foot-pounds is a normal test in the guillotine unit used (Rep. Tr. 63). But the Hensley points (Pl. Exs. 9 and 10) were tested on the guillotine not at six thousand foot-pounds, the normal test, but rather at sixteen thousand foot-pounds and at eighteen thousand foot-pounds, respectively (Rep. Tr. 65-67).

There was no attempt to show any supporting function of the Hensley tongues at the normal testing operation (Rep. Tr. 76). The question of infringement cannot be determined by laboratory tests which amplify the operational characteristics far in excess of what was contemplated for the structure of the Baer patent. *U. S. Slicing Mach. Co. v. Wolf, Sayer & Heller, Inc.*, 243 Fed. 412 N.D. Ill. 1017) *aff'd* 257 Fed. 93 (1919).

There has been no evidence at all to the effect that the Hensley points, in normal field usage, would provide the stabilizing function called for in the Baer patent. Esco having failed to provide any proof that the Hensley structure performs the function of the Baer patent, infringement cannot be found.

CONCLUSION

For the foregoing reasons, Claims 8 and 9 of the Baer patent should be held invalid and not infringed and the judgment below should be reversed with instructions to dismiss the Complaint.

Dated, San Francisco, California,
June 22, 1966.

Respectfully submitted,

FLEHR AND SWAIN

THOMAS O. HERBERT

Attorneys for Appellant

CERTIFICATE

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

THOMAS O. HERBERT

Attorney for Appellant

(Appendix Follows)

Appendix.



Appendix

LIST OF PLAINTIFF'S EXHIBITS

Description	Identified	Offered	Received	With- drawn
1. Plastic replica of Baer tooth	61	61	61	
2. Softy copy of patent in suit, 2,483,032	43	44	44	
3. Wooden model of ESCO R-6 point	60	60	60	
3A. Photo of Exhibit 3	60	60	60	
4. Hensley R-4HX ESCO Type point (1960)	116	116	116	
5. Hensley R-4HX ESCO Type point (1961)	116	116	116	
6. Film	126	126	127	
6A. thru 6P. Photos from above movie film	128	128	128	
7. Baer point	62	129	130	
7A. Photo of Exhibit 7	130	130	130	
8. Baer point—without tongue	64	130	130	
8A. Photo of Exhibit 8	130	130	130	
9. Hensley 6" point	64	131	131	
9A. Photo of Exhibit 9	132	132	132	
0. Second Hensley 6" point	64	131	131	
0A. Photo of Exhibit 10	132	132	132	
1. Copy of Hensley Invoice 2899	116	116	116	
2. Hensley Brochure—1960	116	116	116	
3. Hensley Brochure—1961	116	116	116	
4. C. C. Hensley deposition, 10/4/61	117	117	205	
5. Deposition of Ruston Hensley, 5/27/63	117	117	205	
6. Hensley Brochure	117	117	117	

PLAINTIFF'S EXHIBITS CONTINUED

	Description	Identified	Offered	Received	With- drawn
17.	Deposition of Clyde C. Hensley, 5/27/63	117	117	205	
18.	Hensley salesman's call report, 10/18	117	117	117	
19.	Depositions of Herbert F. Hales and Paul E. Rothwell	117	117	119	
20.	Hensley R-5 pin	145	146	147	
21.	ESCO shipping advice DA71797	146	146	147	
22.	Chart applying patent Claim 5 to Hensley point	147	147	147	
22A.	Reduced scale version of Exhibit 22	148	148	148	
23.	Chart applying patent Claim 8 to Hensley point	147	147	148	
23A.	Reduced scale version of Exhibit 23	148	148	148	
24.	Chart applying patent Claim 9 to Hensley point	147	147	148	
24A.	Reduced scale version of Exhibit 24	148	148	148	
25.	Copy of ESCO drawing DC3595—colored	214	215	216	
26.	Model of Dipper	70			148
27.	Model of Bucket	97			148
28.	Model of clam shell	98			148
29.	Block of metal as part of tests ran	306	306	306	
30.	Drawing and angle measurement made by Mr. Hensley	389	391	391	
31.	Encrusted tooth from Kaiser	577	602	602	
32.	Seven inch Hensley point	599	602	602	

LIST OF DEFENDANTS' EXHIBITS

	Description	Identified	Offered	Received	With- drawn
	ESCO R-3 point	121	121	121	
1.	Packing list, Marshall Newall, re Ex. A	121			121
2.	Greyhound Bus bill re Ex. A	121			121
	ESCO R-34S point	121	121	121	
1.	Packing list, Marshall Newall, re Ex. B	121			121
2.	Invoice, Marshall Newall, re Ex. B	121			121
	ESCO WRR-34 Adapter	122	122	122	
1.	Packing list, Marshall Newall, re Ex. C	122			122
	CAT tooth	122	122	122	
	Hensley R-4HX point (colored)	123	123	123	
1.	Hensley pin for R-4HX	124	124	124	
2.	ESCO adapter R-4	122	122	122	
	Pattern Hensley R-4HX point	124	124	125	
	Pattern Hensley R-6HX point	125	125	125	
	Motion picture, testing of Hensley points	126	127	127	
	Tested & rupture Hensley R-4HX point	133	133	133	
	Tested & ruptured Hensley R-5HX point	133	133	133	
	Tested Hensley R-6HX point	133	133	133	
	Five worn Hensley R-6HX points	133	133	134	
	Certified copy of Baer file wrapper	134	134	134	
	Thomas patent 915,809	134	134	134	
	Berryman patent 957,030	134	134	134	
	Mederios patent 1,014,891	134	134	134	
	Van Buskirk patent 1,925,420	134	134	134	

DEFENDANTS' EXHIBITS CONTINUED

	Description	Identified	Offered	Received	With- drawn
R.	Seal patent 2,134,344	134	134	134	
S.	Hosmer patent 2,251,487	134	134	134	
T.	Crawford patent 2,259,456	134	134	134	
U.	Crawford patent 2,307,359	134	134	134	
V.	Crawford patent 2,312,802	134	134	134	
W.	White patent 2,325,991	134	134	134	
X.	Harrell patent 1,126,759	134	134	134	
Y.	McMonegal patent 1,384,701	134	134	134	
Z.	Meyer patent 1,722,154	136	136	136	
AA.	McKee et al. patent 1,780,397	136	136	136	
BB.	Mekeel patent 1,845,677	136	136	136	
BB1.	Certified copy of Mekeel file wrapper	136	136	136	
CC.	Terry patent 2,279,960	136	136	136	
DD.	British patent 565,417	136	136	136	
EE.	Colored Chart, Baer 2,483,032, Figs 6-10	136	137	137	
FF.	Model of Baer 2,483,032	137	137	137	
GG.	Colored chart of Hensley R-4HX point on ESCO R-4 adapter	137	137	137	
HH.	Chart comparing Baer Claim 8 with Mekeel	137	531	531	
II.	Colored chart showing Mekeel drawing	138	138	138	
JJ.	Colored chart showing Mekeel drawing, altered	138	531	531	
KK.	Model of Mekeel	138	531	570	
LL.	Chart of patents showing spacing to be old	139			570
MM.	Chart of patents showing heavy spike to be old	139			570
NN.	Chart comparing Baer Claim 9 with Mekeel	139	531	531	
OO.	Chart comparing Baer Claim 5 with Mekeel	139	531	531	
PP.	Chart of patents showing resilient block and key to be old	139	139	139	570
QQ.	Mekeel patent 1,951,988	140	140	140	
TT.	Drawing made by Mr. Hensley	355	355	356	